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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,211	01/28/2004	Frederick J. Dojan	005127.00275	2584

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EXAMINER

KAVANAUGH, JOHN T

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 03/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/767,211		DOJAN ET AL.	
	Examiner		Art Unit	
	Ted Kavanaugh		3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2006.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14,16-23,25-37,39-45,47-59,61-64,80,81 and 83-118 is/are pending in the application.
- 4a) Of the above claim(s) 10,16,17,21-23,32,33 and 43-45 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9,11-14,18-20,25-31,34-37,39-42,47-59,61-64,80,81 and 83-118 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1-4-2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

In future prosecution, applicant is strongly encouraged to reduce the number of claims and issues to ensure the quality of examination. It is an extreme burden on the examiner to examine this extraordinary number of independent and dependant claims. Applicant, in this application, has several patentably distinct features all shown in one species, which makes the examination of this application very time consuming. Whether the application has one claim or a thousand claims, the examiner is not given any more time per application. Applicant's cooperation in this application and in other applications would be greatly appreciated. Please.

Election/Restrictions

1. Claims 10,16-17,21-23,32-33,43-45,77-79 and 89-90 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election of species I (figures 1-11) was made **without** traverse in the reply filed on September 14, 2005.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

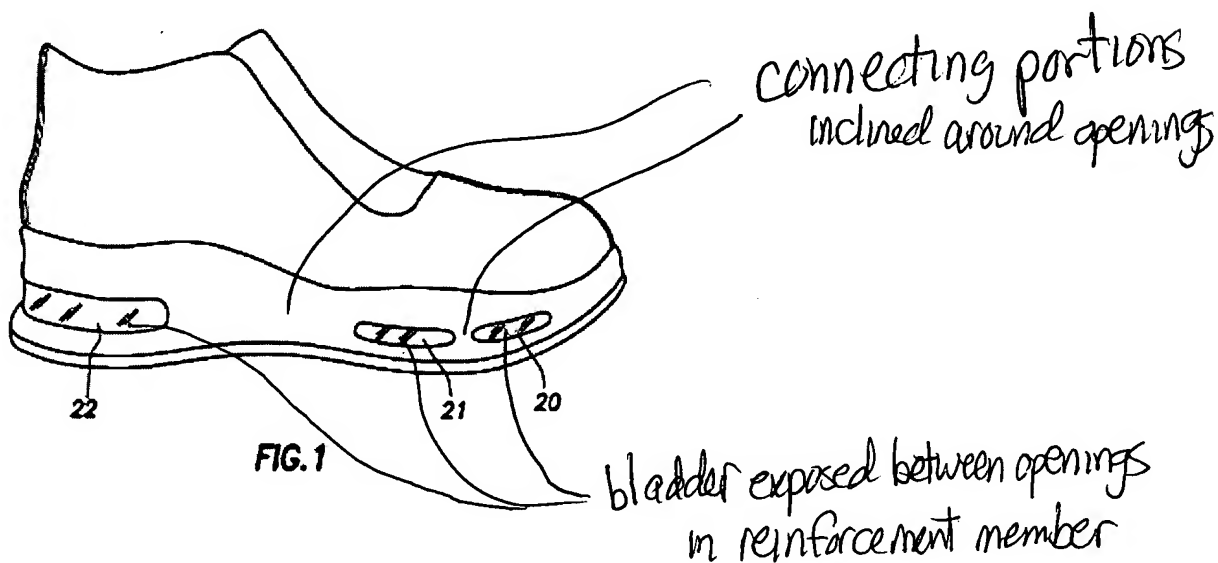
(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 51-56, 61-64, 116 are rejected under 35 U.S.C. 102(b) as being anticipated by US 6009637 (Pavone).

Pavone teaches an article of footwear comprising an upper and a sole structure as claimed; see the marked-up figures below. a sole component as claimed including a bladder and a reinforcing structure at least partially recessed into the barrier material as claimed. See the marked-up figures below. When the bladder is inflated (see col. 2, lines 60-67) to a desired pressure it will inherently place the connecting portions of the reinforcing structure in tension assuming the pressure is greater than atmospheric pressure.



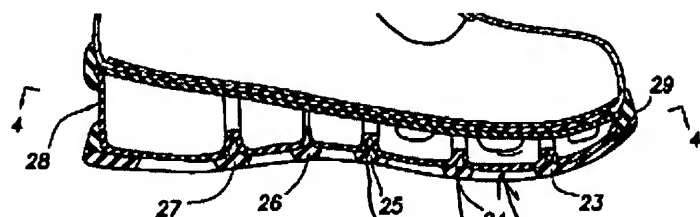


FIG. 3

1st surface

reinforcing structure partially recessed in the 1st surface

connecting portions recessed in sidewall

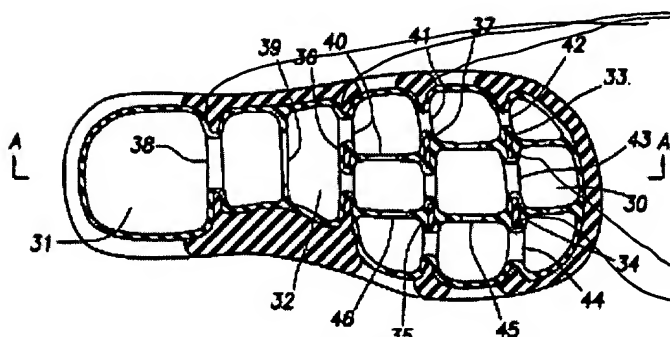


FIG. 4

interior bonds

bladder

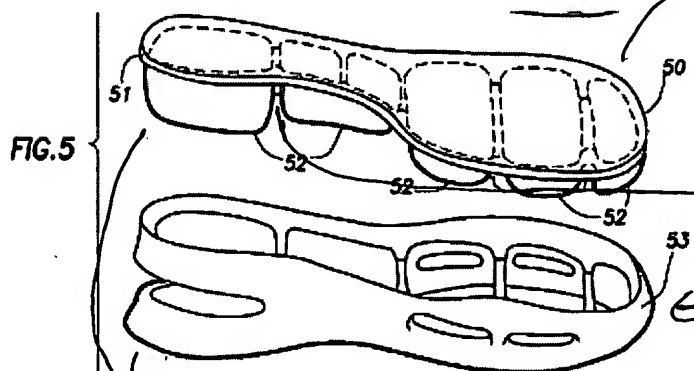


FIG. 5

Flexion Indentations/ Int. bonds

reinforcement member

beveled areas

4. Claims 96-103, 105, 106, 107, 108, 109 are rejected under 35 U.S.C. 102(e) as being anticipated by US 6505420 (Litchfield et al).

Litchfield teaches an article of footwear comprising a bladder (10, SEE FIGURES 1-4)) having flexion indentations and interior bonds as claimed, a reinforcing structure (88, 104) made out of a non-foam which has a ridge extending around a depression in

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the upper surface (see figure 19 and col. 14, lines 16-43). The reinforcing structure has a shore A hardness of 75-95 (see col. 11, lines 23-30) and the bladder has a hardness of 70 (see col. 7, line 41) and therefore the reinforcing structure is made out of a stiffer material and hence has a greater modulus of elasticity.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 51,57,58,59,103,104,117 and 118 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pavone '637 in view of US 6505420 (Litchfield et al.)

Pavone teaches a sole component as claimed (as noted above) except the modulus of elasticity of the materials as claimed. Pavone are silent with regard to the modulus of elasticity. Litchfield teaches a moderator (88) can be made integral with the midsole and has a greater modulus of elasticity than the bladder, see the rejection above for details. It would have been obvious to provide the midsole (53) or reinforcement member as taught above with a moderator, as taught by Pavone, act as a moderator during foot strike (see col. 11, lines 30-32 of Litchfield) and to simply the footwear by eliminating the sock liner or other separate moderating means (see col. 14, lines 39-43 of Litchfield).

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1-9,11-14,18-20,25-31,34-37,39-42,47-59,61-64,80,81,83--88,91-118 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of copending Application No. 10/767212, 10/767465 and 10/767404. Although the conflicting claims are not identical, they are not patentably distinct from each other because the application claim is merely broader than the patent claim and therefore it would be obvious to leave out the other elements.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicant didn't present any argument and therefore applicant should file a Terminal disclaimer in the next response to over this rejection.

Allowable Subject Matter

9. Upon filing a proper terminal disclaimer the following claims will be allowed:

Claims 1-9,11-14,18-20,25-31,34-37,39-42,47-50,80,81,83-88,91-95,110-115 and any of the withdrawn claims that are applicable.

Response to Arguments

10. Applicant's arguments with respect to the rejection claims above have been considered but are moot in view of the new ground(s) of rejection and in view of the claims indicated as being allowable above.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Other useful information can be obtained at the PTO Home Page at www.uspto.gov.

In order to avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly into the Center at (571) 273-8300 **(FORMAL FAXES ONLY)**. Please identify Examiner Ted Kavanaugh of Art Unit 3728 at the top of your cover sheet.

Any inquiry concerning the MERITS of this examination from the examiner should be directed to Ted Kavanaugh whose telephone number is (571) 272-4556. The examiner can normally be reached from 6AM - 4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562.


Ted Kavanaugh
Primary Examiner
Art Unit 3728